

REMARKS

Applicant respectfully requests reconsideration of this application as amended. Claims 20-37 are currently pending in this application. Claims 1-19 and 38 are cancelled. Claims 28, 29, and 32-34 are amended herein. The applicant believes that no new matter is introduced by way of this amendment.

Claim Rejections - 35 U.S.C. §102

Claims 20-21, 24-25, 28-30, 34 were rejected under 35 U.S.C. 102(b) as being anticipated by Erb '345. Applicant respectfully disagrees.

Erb teaches a device for injecting a silicone elastomer into a fallopian tube. The device includes a metal connector 36, which may slide inside an aperture within a tip 10. The tip is brought to a fallopian tube and silicone elastomer is injected therein and cured to form a blocking insert. The metal connector slides in a proximal direction relative to the tip in order to release a cured elastomer insert, see figure 5.

Erb's teachings are fundamentally different from the claimed subject matter. Referring to claim 20, the proximal end of the sheath moves in order to expose and affix the contraceptive device (see the last paragraph of claim 20). The distal end of the first elongate body is disposed within the sheath. Erb teaches that an inner metal connector (which resides within the outer tip) must move relative to an outer tip order to release a cured insert. Erb teaches an arrangement which is the opposite of applicant's claimed subject matter because the outer tip remains stationary and is not disposed within a sheath.

Furthermore, Erb inherently teaches that the insert is affixed prior to releasing the elastomer, because the elastomer is injected in a liquid form. Therefore curing the elastomer affixes the insert, and movement of the inner connector or tip is irrelevant to affixing the device.

Erb is also silent as to how the operation as shown in figure 5 is achieved with relation to use of the handle. Erb teaches two mechanisms for the handle; drums 34 for steering the tip and a dispensing means 24 for injecting elastomer. Applicant believes that the wires (32, 30) which are attached to drums 34 for steering could not inherently be used for actuation of the inner metal connector. It is clearly shown that the wires are attached to the outer portion of the device in figure 3. Therefore applicant believes that Erb does not teach a handle mechanism, explicitly or inherently, for releasing a contraceptive device.

In light of the foregoing arguments applicant believes that claims 20-21, 24-25, 28-30, 34 are not anticipated by Erb '345, and respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. 102(b).

Claim Rejections - 35 U.S.C. §103(a)

Claims 22-23, 26-27, 32-33 and 37-38 were rejected under 35 U.S.C. 103(a) as being unpatentable over Erb in view of Cohen '396. Applicant respectfully disagrees.

As shown above the base claims from which the rejected claims depend are not anticipated by the primary reference, Erb, and the addition of Cohen does not remedy the lack of teachings of Erb. Therefore applicant believes the combination fails to present a case for *prima facia* obviousness.

In light of the foregoing arguments applicant believes that claims 22-23, 26-27, 32-33 and 37-38 are patentable over Erb in view of Cohen '396, and respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. 103(a) be withdrawn.

Double Patenting

Claims 20-38 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent 6,709,667. Claims 20-38 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17-23 of U.S. co-pending Application 11/154,144. Applicant respectfully disagrees. However, in order to expedite the prosecution of the application, appropriate terminal disclaimers are submitted herewith without agreeing with this rejection.

In light of the foregoing arguments applicant believes that claims 20-38 are patentable over the above references, and respectfully requests the Examiner to withdraw the double patenting rejection.

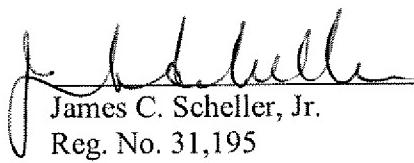
Applicant respectfully submits that in view of the amendments and arguments set forth herein, the applicable rejections have been overcome.

Please charge any shortages and credit any overcharges to our Deposit Account
No. 02-2666.

Respectfully submitted,

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